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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,688	08/31/2001	Richard A. Burgin	10017723-1	2115

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/944,688

Applicant(s)

BURGIN ET AL.

Examiner

David Lazaro

Art Unit

2155

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3, 7-9 and 13-15 as set forth in office action mailed 05/19/05.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

SALEH NAJJAR
PRIMARY EXAMINER

David Lazaro
July 25, 2005

Continuation Sheet

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicants argue on page 11 of the remarks- *"Applicants submit that Venkatraman does not disclose "obtaining a set of multiple digital images" in which "one or more of the images of the set of multiple digital images are a digital-image format that differs from the digital-image format of one or more of the other images of the set of multiple images" Instead, Venkatraman merely discloses a list of possible digital-image formats for its subject digital images. Specifically, the cited text of Venkatraman (col. 5, lines 62-67 states....Applicant submits that Venkatram fails to disclose that its subject digital images in its "container" include images of differing formats. While the above cited text indicates that the digital images in Venkatraman's containers are not limited to any particular digital format, Applicant submits that this is not equivalent to specifying that images in the container differ in format."*

a. Examiner's Response - The office action also sites Col. 6, lines 51-66, which states, "...component definitions are created by the sender in a step 65. There can be **any number of component definitions desired...**" (emphasis added). This establishes the container (self-contained album) is made up of any number of components. Col. 5, lines 62-67, is a description of a "Data Location" and the associated 'data field' for a component object. The 'data field' can include, as noted by applicants, image data in any digital format. Furthermore, Venkatraman never explicit states or suggests that all the component objects must contain the same digital format. If there are any number component objects and each of these component objects can have "any particular digital format" as noted by applicant, and Venkatraman furthermore, never discloses that

component objects must contain the same digital format, then it is explicitly clear that the teachings of Venkatraman are within the scope of the limitations *"obtaining a set of multiple digital images" in which "one ore more of the images of the set of multiple digital images are a digital-image format that differs from the digital-image format of one or more of the other images of the set of multiple images"*.

b. This is further supported by Venkatraman throughout the disclosure. Part of the reason for the invention of Venkatraman is because "E-mail messages typically lack interesting **different types of content**" (Col. 1 lines 34-36, emphasis added). Col. 1, lines 64-66, states "On the sender side, creation software implements a data format that **allows for differing types of digital content.**" (emphasis added). Col. 4, lines 53-58, states that the number of files included in the container is "determined by **the different number and type of images**, sound, and functional attributes that the sender inserts" (emphasis added). Applicants are attempting to argue that Venkatraman restricts a container to a single format which is obviously far from the case based on the purpose and structure of Venkatraman's invention.

2. Applicants argue on pages 11-12 of the remarks - *"Indeed, Applicant respectfully submits that, without an explicit statement in Venkatraman that is container included images of differing formats, it is reasonable to assume that all of the images in its containers have the same digital-image format."*

c. Examiner's response - The examiner first notes that by the same logic, without an explicit statement that the container includes images having the same digital format, it is reasonable to assume that images in the container can have differing image formats.

d. The examiner also asserts that the images in the container, based on the disclosure of Venkatraman, can have either all the same digital image format, or differing digital image formats. This is ultimately up to the user of the system when creating the container to be sent as described in Col. 6, lines 51-66. There is nothing in the disclosure of Venkatraman to suggest otherwise.

3. Applicants argue on page 12 of the remarks - *"...More particularly, Applicant asks the Office to note that Venkatraman does not include a similar cautionary statement regarding differing image formats...Applicant submits that a lack of differing format cautionary statement in Venkatraman lends support to Applicant's position that Venkatraman fails to disclose that its subject digital images in its "container" include image of differing formats."*

e. The component definitions described in Col. 6, lines 56-60, are directly related to the images and image formats described in Col. 5, lines 62-67. Each component definition may have image data of any particular format. And as described by Col. 6, lines 56-60, there may be any number of component definitions.

f. Furthermore, since the cautionary statement in Col. 6 lines 56-60 is also directly related to different types of content including different types of image formats, then by applicants own reasoning, Col. 6 lines 56-60 would actually

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support the position that the images in the container include images of differing formats.

4. The remaining arguments are of similar context as those addressed above and are therefore responded to under the same logic as argued above.